

REMARKS

Claims 1-30 are pending, but stand rejected. Claims 26, 31, and 32 have been cancelled. Claims 11, 19, 21, 23, and 24 have been amended. In view of the following remarks, the Applicant respectfully asks that the Examiner reconsider and withdraw the rejections.

Drawings: The Examiner objected to the Drawings. New Drawings accompany this response.

Specification: The Examiner objected to a typographical error in the specification. The specification has been amended.

Claim Objections: The Examiner objected to Claim 32. Claim 32 has been cancelled.

Claim Rejections – 35 USC §103: The Examiner rejected Claims 9, 19, 23, 24, 31, and 32 under §112. Claims 9, 19, 23, and 24 have been amended to address the Examiner's concerns. Claims 31 and 32 have been cancelled.

Claim Rejections – 35 USC §101: The Examiner rejected 31 and 32 under §101. Claims 31 and 32 have been cancelled.

Claim Rejections – 35 USC §103: Claims 1-9, 14, 19, 26, and 31 were rejected as being unpatentable over USPN 5,917,925 issued to Moore in view of a newspaper article written by Patchett.

Claim 1 is directed to a method for sending an article in a postal system and recites the following:

1. causing an identifier to be associated with information in a database;
2. marking an article with the identifier;
3. enabling the identifier after the occurrence of a predetermined event; and
4. checking whether the identifier is enabled before delivering the article.

The Examiner contends that Moore teaches the first, second, and fourth elements above, but admits that "Moore fails to disclose enabling the identifier after the occurrence of a predetermined event." In a flawed attempt to address this deficiency, the Examiner relies on Patchett stating that "Patchett discloses enabling an identifier (a credit card number) after the occurrence of a predetermined event (consumer calling a toll-free number to activate the credit card) (p.1, 3rd paragraph from bottom)."

Patchett discusses a practice in which credit card companies require the recipient of a credit card to call in and provide some form of identifying information before an account associated with that credit card is enabled or otherwise activated. Only upon receiving the credit card is the recipient provided with instructions to activate the card. In other words, the account is not activated or enabled until after the credit card has been delivered.

The Examiner mistakenly contends that it "would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the article-mailing method of Moore such that the identifier is not enabled until after the occurrence of a predetermined event as disclosed by Patchett." The Examiner also states that "Patchett provides motivation in that not enabling an identifier until after a predetermined event can help prevent fraudulent activity that might have otherwise occurred in the time period before the identifier was enabled."

It is well settled that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01. Such is the case here.

Moore discusses a system in which postmarked mail pieces (articles) enter a postal mail system and those postmarks (identifiers) are examined, prior to deliver, to determine their authenticity. See, e.g., Moore, col. 4, lines 26-46. Patchett, as discussed above, refers to a system in which a credit card (article) is actually delivered before an account (identifier) associated with the credit card is activated (enabled). Logically, the credit card account discussed by Patchett cannot be activated until that card is delivered and the recipient is provided with the activation instructions.

Modifying the teachings of Moore with that which is discussed by Patchett would render Moore unsatisfactory for its intended purpose. It would make no sense to verify and enable a postmark after the parcel containing that postmark has been delivered. This is why Moore discusses the validation of a parcel's postmark before that parcel is delivered.

Consequently, there is no motivation to make the modification of Moore proposed by the Examiner. As such, the Examiner's reliance on the combination of Moore and Patchett is improper, and Claim 1 is patentable over the cited references as are Claims 2-10 which depend from Claim 1.

Claims 4, 19, 26, are discussed below.

Claim 31 has been cancelled.

Claim Rejections – 35 USC §102: Claims 11, 13, 14, 16-18, 21-23, 25, 27, and 29-30 were rejected as being anticipated by Moore.

Claim 11 is directed to a method for sending an article in a postal system and, as amended, recites the following:

1. causing an identifier to be associated with address information in a database;
2. marking an article with the identifier;
3. enabling the identifier after the occurrence of a predetermined event; and
4. checking whether the identifier is enabled and comparing the address information associated with the identifier with addressee information on the article before delivering the article.

It is noted that the Examiner admits that "Moore fails to disclose enabling the identifier after the occurrence of a predetermined event." Further, the Examiner is reminded that there is no motivation to modify Moore with Patchett to when addressing the elements of Claim 11.

For at least the same reasons, Claim 1 is patentable over Moore and over the combination of Moore and Patchett, so are Claim 11 and Claims 12-20 which depend from Claim 11.

Claim 21 is directed to a system for tracking an article having an identifier and a recipient address and, as amended recites the following:

1. a reader configured to read information from said article;
2. a database including identifier data associated with at least one identifier;
3. means for retrieving data from the database and reviewing the data;
4. means for enabling said identifier after the occurrence of a predetermined event; and
5. means for verifying enablement of said identifier before delivering the article.

It is noted that the Examiner admits that "Moore fails to disclose enabling the identifier after the occurrence of a predetermined event." As such, Moore also fails to teach a means for doing so. Further, the Examiner is reminded that there is no motivation to modify Moore with Patchett to when addressing the elements of Claim 21.

For at least the same reasons, Claim 1 is patentable over Moore and over the combination of Moore and Patchett, so are Claim 21 and Claims 22-25, and 27-30 which depend from Claim 21.

Claim 26 has been cancelled.

Claim 30 has been cancelled.

Claim Rejections – 35 USC §103: Claim 10 was rejected as being unpatentable over Moore in view of Patchett, and in further view of USPN5,415,341 issued to Diamond.

Claim 10 depends from Claim 1 and includes all of the limitations of that base Claim. For at least the same reasons Claim 1 is patentable, so is Claim 10.

Claim Rejections – 35 USC §103: Claims 12, 15, and 24 were rejected as being unpatentable over Moore.

Claims 12 and 15 depend from Claim 11 and includes all of the limitations of that base Claim. For at least the same reasons Claim 11 is patentable, so are Claims 12 and 15.



Claim 24 depends from Claim 21 and includes all of the limitations of that base Claim. For at least the same reasons Claim 21 is patentable, so is Claim 24.

Claim Rejections – 35 USC §103: Claims 20 and 28 were rejected as being unpatentable over Moore in view of Diamond.


Claims 20 depends from Claim 11 and includes all of the limitations of that base Claim. For at least the same reasons Claim 11 is patentable, so is Claim 20.

Claim 28 depends from Claim 21 and includes all of the limitations of that base Claim. For at least the same reasons Claim 21 is patentable, so is Claim 28.

Conclusion: In view of the foregoing remarks, the Applicant respectfully submits that the pending claims are in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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